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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,558	01/27/2000	James R. Gannoe	14635-012610US	1021
27777	7590	02/06/2004		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER PHILOGENE, PEDRO	
			ART UNIT	PAPER NUMBER
			3732	28
DATE MAILED: 02/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,558

Applicant(s)

GANNOE ET AL.

Examiner

Pedro Philogene

Art Unit

3732

JH

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 14, 15, 17-19 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 15 and 49-51 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 8, 17-19 and 52-54 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Allowable Subject Matter

The indicated allowability of claims 1-3, 8, is withdrawn in view of the newly discovered reference(s) to Koros et al and Green, II et al.,. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,17-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Koros et al. (6,113,534).

With respect to claim 1, Koros et al discloses an apparatus (10) for stabilizing an epicardial surface of the heart comprising an shaft (16); and a foot (12) coupled to the shaft, the foot having a first arm, a second arm; as best seen in the FIGS., and a space (14) between the first and second arm, the first and second arm each having a contact surface for engaging the heart; as best seen in FIG.1; a proximal end and a distal end and a length defined between the proximal and distal ends and within a plane defined by the bottom surface of the foot; the length of the first arm being longer than the length of the second arm; as best seen in the FIGS.

With respect to claims 17-19, the method steps, as set forth would have been inherently carried out in the operation of the device, as set forth above.

Claims 4,5, 8, 17-19, 52-54 is rejected under 35 U.S.C. 102(e) as being anticipated by Green, II et al. (6,656,113).

With respect to claim 4, Green et al disclose an apparatus for stabilizing an epicardial surface of the heart comprising an shaft (3); a foot (765,762) coupled to the shaft, the foot having a contact surface for engaging the heart and a slot; as best seen in FIGS. 52 A-B, in which a vessel on the heart may be positioned, the slot being aligned with a central axis, the foot having a shape which is asymmetrical relative to the central axis; as best seen in FIGS. 52 A-B, 53,54.

With respect to claim 5, Green et al disclose all the limitations; as best seen in FIGS 52, A-B, 53, 54.

With respect to claim 8, Green et al disclose an apparatus (30) for stabilizing an epicardial surface of the heart comprising an shaft (3); a foot (765,762) coupled to the shaft, the foot having a contact surface for engaging the heart and a slot; as best seen in FIGS. 52 A-B, in which a vessel on the heart may be positioned, the slot defining an axis, wherein the foot is attached to the shaft at a location offset from the axis, the foot having a lateral side; and the shaft is attached to the foot along the lateral side; as best seen in FIGS. 38-52.

With respect to claim 52, Green, II et al discloses an apparatus (30) for stabilizing an epicardial surface of the heart comprising an shaft (3); a foot (765,762) having a first arm, a second arm; each having proximal and distal ends; as best seen in the FIGS.,

the first and second arm each having a contact surface for engaging the heart; as best seen in FIGS.39-55; a space (716) between the first and second arms defining a slot the slot defining a long axis of the foot; a connector (551) for detachably engaging the foot to the shaft; the connector located along a lateral side of the foot, and forming an axis which makes an angle with the long axis of the foot; as set forth in column 30, lines 36-48.

With respect to claims 53-54, Green II, et al disclose all the limitations; as set forth in column 30, lines 36-48.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koros et al. (6,113,534).

It is noted that Koros et al did not teach of an apparatus wherein the first arm is at least 30% longer than the second arm; as claimed by applicant. However, applicant fails to establish the criticality of such a percentage and the examiner believes that any percentage could have been used since the device would have performed equally as well with any given percentage.

Allowable Subject Matter

Claims 14,15, 49-51, are allowed.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

Applicant's arguments with respect to claims 1,2,4,5,8,17-19, 52-54, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PEDRO PHILOGENE
PRIMARY EXAMINER

Pedro Philogene
February 2, 2004